

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-7, 9-19, 21-25, and 28-34 are pending in this application.

In the outstanding Official Action, Claims 1-7, 9-12, 28, 29, and 31-34 were rejected under 35 U.S.C. §103(a) as unpatentable over Klein et al. (U.S. Patent No. 5,726,885, herein "Klein") in view of Steinberg et al. (U.S. Patent No. 6,628,325, herein "Steinberg"); and Claims 13-19, 21-25, and 30 were rejected under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg and further in view of Shiota et al. (U.S. Patent No. 6,657,660, herein "Shiota").

With regard to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg, that rejection is respectfully traversed.

Claim 1 recites in part:

the client terminal comprises an image transmission method designating unit configured to designate, *at the time of reservation, server terminal information related to a method of transmission of input image data once the information device is returned and a transmission address*, ..., and the server terminal transmits the input image data to the transmission address based on the method of transmission.

The outstanding Office Action conceded that there is no teaching or suggestion in Klein for "an image transmission method designating unit" as recited in Claim 1.¹ The outstanding Office Action cited Steinberg as describing "an image transmission designation unit configured to transmit an input image."² However, Steinberg at most describes a digital camera 10 that can receive commands regarding data transmission. As there is no teaching or suggestion in Steinberg regarding making a reservation, Steinberg cannot teach or suggest a device configured to designate, *at the time of reservation*, a method of transmission of data

¹See the outstanding Office Action at page 4, lines 1-3.

²See the outstanding Office Action at page 4, lines are

or a transmission address. Thus, neither Klein nor Steinberg teach or suggest “an image transmission method designating unit *configured to designate, at the time of reservation,* server terminal information related to a method of transmission of input image data once the information device is returned *and* a transmission address” as recited in amended Claim 1.

The outstanding Office Action further asserted that “[t]he intended manner of use of the structure has little patentable weight. It appears that applicant is trying to identify the system by what it does or by a property or characteristic it has rather than by what it is. It is not clear to the Examiner, how the timing of the designation, would change the structure of the system. If there is a designation device that allows for some sort of instruction as to how the image is to be transmitted, and the claim language has been met. The prior art apparatus must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has a reason to believe that the functional limitation can be performed by the prior art structure, the burden is on the applicant to prove otherwise. In this case, the Examiner has a reason to believe that the prior art structure can transmit input image data. Furthermore, the Examiner asserts that Steinberg discloses designating the transmission of input image in a transmission address.”³ Again, no authority of any kind was cited to support this reasoning, which is clearly contrary to well settled case law.

Initially, it is respectfully noted that the invention recited in Claim 1 includes a server terminal that is configured to transmit the input image data to a transmission address based on a method of transmission which are both designated by the image transmission method designating unit *at the time of reservation*. Thus, as noted above, as neither Klein nor Steinberg teach or suggest any apparatus configured to designate at the time of a reservation a method of transmission *or* a transmission address, the proposed combination of Klein in view of Steinberg does not teach or suggest each and every claim element of Claim 1.

³The outstanding Official Action at page 18, line 17 to page 19, line 7.

With regard to the statement “[t]he intended manner of use of the structure has little patentable weight,” this statement is clearly contrary to *In re Schreiber*, which holds that while features of an apparatus may be recited either structurally *or functionally*, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In the present case, Claim 1 recites a structural element, an image transmission method designating unit, whose feature is defined functionally, in accordance with *In re Schreiber*. By concluding that a structure defined functionally is an intended use, the Office Action contradicts the holding of *In re Schreiber*.

With regard to the statement “It is not clear to the Examiner, how the timing of the designation, would change the structure of the system,” it is respectfully submitted that the invention recited in Claim 1 includes an image transmission method designating unit that has structure that functions to designate, at the time of reservation, server terminal information related to a method of transmission of input image data once the information device is returned and a transmission address, in accordance with *In re Schreiber*. Neither Klein nor Steinberg teach or suggest any such unit with this structure, nor has any portion of Klein or Steinberg been cited as describing such unit. At best, the Office Action asserts that the device of Steinberg could be modified to include such a structure. However, this does not provide a *prima facie* case obviousness as Steinberg does not teach or suggest “an image transition method designating unit” as defined in Claim 1.

With respect to the statement “If the Examiner has a reason to believe that the functional limitation can be performed by the prior art structure, the burden is on the applicant to prove otherwise,” it is again noted that this statement is contrary to *In re Schreiber* and *In re Royka*, which holds that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*,

490 F.2d 981, 180 USPQ 580 (CCPA 1974). Thus, only a teaching or suggestion in a cited reference can serve to render an element obvious, not “a reason to believe that the functional limitation can be performed by the prior art structure.” Moreover, no authority has been cited to support the assertion that “the burden is on the applicant to prove otherwise” either. Again, at best the Office Action asserts that the device of Steinberg could be modified to include such a structure.

Finally, with regard to the statement “In this case, the Examiner has a reason to believe that the prior art structure can transmit input image data. Furthermore, the Examiner asserts that Steinberg discloses designating the transmission of input image in a transmission address,” it is respectfully noted that the applicant does not dispute that Steinberg can transmit input image data. However, Steinberg does not teach or suggest that a server terminal transmits the input image data based on the method of transmission to a transmission address designated by an image transmission method designating unit *at the time of reservation*. To the extent that the outstanding Office Action ignores these additional features of the claimed invention in making the present rejection, this is contrary to *In re Wilson*, which holds that *all words in a claim* must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (Emphasis added).

Consequently, as Klein and Steinberg do not teach or suggest each and every element of amended Claim 1, amended Claim 1 (and Claims 2-7, 9-12, 32, and 33 dependent therefrom) is patentable over Klein in view of Steinberg.

As independent Claims 28 and 31 recite similar elements to Claim 1, Claims 28 and 31 (and Claims 29 and 30 dependent therefrom) are patentable over Klein and Steinberg for at least the reasons discussed above with respect to Claim 1.

With regard to the rejection of Claim 13 under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg and further in view of Shiota, that rejection is respectfully traversed.

Claim 13 recites in part:

the client terminal comprises an image transmission method designating unit *configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data once the information device is returned and a transmission address, ...* and the server terminal transmits the input image data to the transmission address based on the method of transmission.

The outstanding Office Action conceded that there is no teaching or suggestion in Klein for “an image transmission method designating unit” as recited in Claim 13. The outstanding Office Action cited Steinberg as describing “an image transmission designation unit configured to transmit an input image.”⁴ However, as noted above, the cited portions of Steinberg at most describe a digital camera 10 that can receive commands regarding data transmission. There is no teaching or suggestion in Steinberg regarding making a reservation. Thus, Steinberg cannot teach or suggest a device configured to designate, *at the time of reservation*, a method of transmission of data *or* a transmission address. Consequently, it is respectfully submitted that Steinberg also does not teach or suggest “an image transmission method designating unit *configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data once the information device is returned and a transmission address*” as recited in amended Claim 13. Further, it is respectfully submitted that Shiota does not teach or suggest this element either.

⁴See the outstanding Office Action at page 12, lines 13-18.

The outstanding Office Action again makes unsupported assertions⁵ similar to those quoted above, which are submitted to be contrary to well settled case law, as noted above. Consequently, as Klein, Steinberg, and Shiota do not teach or suggest each and every element of amended Claim 13, amended Claim 13 (and Claims 14-19 and 21-25 dependent therefrom) is patentable over Klein in view of Steinberg and further in view of Shiota.

With regard to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg, that rejection is respectfully traversed.

It is respectfully submitted that Claims 33 and 34 recite subject matter that further defines over the cited references. Claim 33 recites in part “said image transmission method designating unit is configured to designate, at the time of reservation, reservation start information and reservation return information.” Claim 34 recites in part “said image transmission method designating unit is configured to designate, at the time of reservation, reservation start information including a date and time a reservation will start and reservation return information including a date and time the reservation will end.”

The outstanding Office Action apparently cited Steinberg as describing this subject matter, but no portion of Steinberg was provided by the Office Action. It is respectfully submitted that none of the cited references teach or suggest a unit configured to additionally designate, *at the time of reservation*, reservation start information and reservation return information as recited in new Claim 33, much less reservation start information including a date and time a reservation will start and reservation return information including a date and time the reservation will end as recited in new Claim 34. Consequently, it is respectfully submitted that a *prima facie* case of obviousness has not been made with respect to Claims 33 and 34.

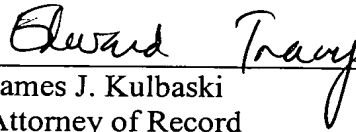
⁵See the outstanding Office Action at page 13, lines 13-21.

Application No. 09/753,582
Reply to Office Action of May 21, 2007

Accordingly, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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